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09/925,767	08/09/2001	George Kataoka	TKA0031	4839

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EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,767

Applicant(s)

KATAOKA, GEORGE

Examiner

Krishnan S Menon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claims 1-35 are pending.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-30 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-10 of copending Application No. 10/021847. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27, 31 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 27, 31 and 35 recite the limitation "said reinforcing". There is insufficient antecedent basis for this limitation in the claim. Examiner considered them as depending from claims 25, 29 and 33 to overcome this issue for examination purpose.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-7, 11, 13-18, 24 and 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 5-40843 (Y2).

JP'843 teaches a filter device comprising a body with an open frame (1), blind frame (6,7), annular bottom member (3), a chamber for substance to be extracted (inside 3), with the blind frame; the body and the frames with the filter chamber could be folded up (blind frame inside the open frame) when not in use and expanded to a cup shape when in use as in instant claims 1 and 14 (fig 1-7). Open frame tubular as in claim 2. Container has a varied diameter from open frame to blind frame and forms an inverted cone as in instant claims 3 and 15. The open frame, the body and the blind frame have substantially the same height as in instant claims 4-6 and 16-18 (see fig 1,7). The blind frame can be twice as long as the open frame as in claim 7 (see figures). The body and frames are made of material having predetermined rigidity as in instant claims 11 and 24. Re material of construction, JP teaches synthetic resins such as polypropylene for the filter materials as in claims 13 and 32.

2. Claims 14-20, 24 and 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nordskog (US 4,867,993).

Nordskog (993) teaches a filter device comprising a body with an open frame (22,22a), blind frame (18,18b), annular bottom member (14,14 a), a chamber for substance to be extracted (16, 16a), with the blind frame; the body and the frames with the filter chamber could be folded up when not in use and expanded to a cup shape when in use as in instant claim 14 (fig 1-7). Container has a varied diameter from open frame to blind frame and forms an inverted cone as in instant claim 15. The open frame, the body and the blind frame have substantially the same height as in instant claims 16-18 (see fig 1,7). The body and frames are made of material having predetermined rigidity as in instant claim 24, like paper as in instant claim 28 (col 2 lines 1-16). The upper end of blind end frame is extended along an inner peripheral face of the blind frame and integrally connected thereto as in instant claim 19 (see fig 7). The upper end of blind end frame is extended along an outer peripheral face of the blind frame and integrally connected thereto as in instant claim 20 (see fig 1 and 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 12 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'843 in view of Nordskog (993).

JP teaches all the limitations of claims 1 and 14. Claims 12 and 28 add further limitation of paper as material for the filter which JP does not teach. Nordskog (993) teaches paper for the filter (col 2 lines 1-16). It would be obvious to one of ordinary skill in the art at the time of invention to use paper as taught by Nordskog in place of synthetic resin as taught by JP for easy disposal.

4. Claims 8-10, 21-23, 25-27 and 33-35 rejected under 35 U.S.C. 103(a) as being unpatentable over JP'843 in view of Hayes (US 4,520,716).

JP'843 teaches all the elements of the instant claims as in claims 1 and 14 above and the plurality of connecting pieces integrally connecting the open frame and the blind frame together (see figures) as in instant claim 10, 23, 27 and 35; except for the reinforcing frame of predetermined rigidity formed on the blind frame and which forms a cup holding frame as in claims 8, 9, 21, 22, 25, 26, 33 and 34. Hayes (716) teaches the reinforcing frame forming a cup holder in a coffee maker filter (fig 1b, 1 and 1a) as in the instant claims. It would be obvious to one of ordinary skill in the art at the time of invention to use the teachings of Hayes (716) to have a cup holder incorporated into the teachings of JP'843 for attaching the filter on a coffee-cup.

5. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'843 in view of Nordskog (993) as applied to claim 28 above and further in view of Hayes (US 4,520,716).

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JP '843 in view of Nordskog (993) teaches the plurality of connecting pieces integrally connecting the open frame and the blind frame together (see figures) as in instant claim 31, but does not teach the reinforcing frame. Hayes (716) teaches the reinforcing frame forming a cup holder in a coffee maker filter (fig 1b, 1 and 1a) as in the instant claims. It would be obvious to one of ordinary skill in the art at the time of invention to use the teachings of Hayes (716) to have a cup holder incorporated into the teachings of JP'843 in view of Nordskog for attaching the filter on a coffee-cup.

6. Claims 1-7, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nordskog (US 4,867,993) in view of JP '843.

Nordskog (993) teaches a filter device comprising a body with an open frame (22,22a), blind frame (18, 18b), annular bottom member (14,14 a), a chamber for substance to be extracted (16, 16a), with the blind frame; the body and the frames with the filter chamber is could be folded up when not in use and expanded to a cup shape when in use as in instant claim 1 (fig 1-7).

Nordskog does not teach that the blind end frame is foldable into the inside of the open frame. JP'843 teaches a filter wherein the blind-end frame is foldable into the open frame (see figures). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of JP'843 in the teaching of Nordskog for the filter for more compact folding.

Claims 2-6, 11 and 12 add further limitations as follows: The open frame is tubular as in instant claim 2 (22 a, 22 b, fig 5 and 7). Container has a varied diameter from open frame to blind frame and forms an inverted cone as in instant claim 3. The open frame, the body and the blind frame have substantially the same height as in instant claims 4-6 (see fig 1,7). The body and frames

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are made of material having predetermined rigidity as in instant claim 11, like paper as in instant claim 12 (col 2 lines 1-16).

Re claim 7, Nordskog (993) teaches all the elements as in claim 1 above, except the height of the blind frame being substantially twice that of the open frame. However, it would be obvious to one of ordinary skill in the art at the time of invention that the height of the blind frame and the open frame is a matter of design preference and could be set any convenient value.

(Applicant may please note a spelling error in claim 1: 'flame' in line 2 should be 'frame')

7. Claims 21-23, 25-27 and 29-31 rejected under 35 U.S.C. 103(a) as being unpatentable over Nordskog (US 4,867,993) in view of Hayes (US 4,520,716).

Nordskog (993) teaches all the elements of the instant claims as in claim 14 above and the plurality of connecting pieces integrally connecting the open frame and the blind frame together (the members between the accordion folds 30a in fig 5) as in instant claim 23, 27 and 31; except for the reinforcing frame of predetermined rigidity formed on the blind frame and which forms a cup holding frame as in claims 21, 22, 25, 26, 29 and 30. Hayes (716) teaches the reinforcing frame forming a cup holder in a coffee maker filter (fig 1b, 1 and 1a) as in the instant claims. It would be obvious to one of ordinary skill in the art at the time of invention to use the teachings of Hayes (716) to have a cup holder incorporated into the teachings of Nordskog (993) for attaching the filter on a coffee-cup.

8. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nordskog (993) in view of JP'843 as applied to claim 1 above, and further in view of Hayes (716).

Nordskog (993) in view of JP'843 also teach the plurality of connecting pieces integrally connecting the open frame and the blind frame together (the members between the accordion folds 30a in fig 5) as in instant claim 10; but does not teach the reinforcing frame of predetermined rigidity formed on the blind frame and which forms a cup holding frame as in claims 8 and 9. Hayes (716) teaches the reinforcing frame forming a cup holder in a coffee maker filter (fig 1b, 1 and 1a). It would be obvious to one of ordinary skill in the art at the time of invention to use the teachings of Hayes (716) to have a cup holder incorporated into the teachings of Nordskog (993) for attaching the filter on a coffee-cup.

9. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nordskog (US 4,867,993) in view of Koslow et al (US 6,103,116).

Nordskog teaches all the elements of claim 14. Claim 32 adds further limitation of the non-woven fabric for the open frame and the blind frame which Nordskog does not teach. Koslow teaches having non-woven fabric for the filter (col 4 lines 10-15). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Koslow in the teaching of Nordskog for the filter material to obtain higher flow rates as taught by Koslow.

10. Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nordskog (US 4,867,993) in view of Koslow et al (US 6,103,116) as applied to claim 32 above, and further in view of Hayes (US 4,520,716).

Nordskog (993) in view of Koslow (116) teaches all the elements of the instant claims as in claim 32 above and the plurality of connecting pieces integrally connecting the open frame and the blind frame together (the members between the accordion folds 30a in fig 5) as in claim 35; except

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for the reinforcing frame of predetermined rigidity formed on the blind frame and which forms a cup holding frame as in claims 33 and 34. Hayes (716) teaches the reinforcing frame forming a cup holder in a coffee maker filter (fig 1b, 1 and 1a) as in the instant claims. It would be obvious to one of ordinary skill in the art at the time of invention to use the teachings of Hayes (716) to have a cup holder incorporated into the teachings of Nordskog (993) for attaching the filter on a coffee-cup.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nordskog (993) in view of JP'843 (408) as applied to claim 1 above, and further in view of Koslow (116).

Nordskog in view of JP does not teach non-woven fabric. Koslow teaches having non-woven fabric for the filter (col 4 lines 10-15). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Koslow in the teaching of Nordskog for the filter material to obtain higher flow rates as taught by Koslow.

Response to Arguments

Applicant's arguments filed on 3/26/03 have been fully considered but they are not persuasive.

Re applicant's argument on the blind end frame: Ref Nordskog shows a blind-end frame at 18 or 18 a in the figures. Exhibit A applicant provided to explain the blind end shows the inside bottom of a cup as the blind end with a skirt around the bottom end of the cup for attaching to a holder. This exhibit explains in col 3 lines 48-52 that the skirt can be completely removed to have the "blind end" 30 as the cup bottom to increase the hold-up volume. Ref Nordskog shows a similar blind end.

Re argument that the blind end frame does not fold into (examiner assumes that by this applicant means "folds inside") the open frame: the secondary reference teaches it. Incidentally, claim 14 does not recite this feature.

Re the argument that Nordskog configures the filter for a beverage brewing and dispensing machine, and is not for a coffee cup: Nordskog teaches a cup-shaped filter, whatever is the intended use. Hayes teaches a feature to attach such a filter to a coffee cup. One skilled in the art could easily combine the features. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)

Regarding the argument that Koslow ref does not overcome the deficiencies of Nordskog, this reference is relied upon only for the non-woven fabric.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 703-305-5999. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Krishnan Menon
Patent Examiner
May 8, 2003


W. L. WALKER
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